

Remarks/Arguments:

Claim 24, newly presented, and claims 1-13, 16-21, and 23, previously of record, are pending.

Claims 1-13, 16-21 and 23 stand withdrawn, pursuant to restriction.

Claims 14, 15, and 22 are canceled, without prejudice or disclaimer.

New claim 24 corresponds to examined claim 22, amended as explained below, in discussing the rejections of record.

Claim 22 was rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement. Reconsideration is requested.

Present replacement claim 24 does not recite "(ii) derivatives thereof," the subject matter—of rejected claim 22—allegedly lacking written descriptive support. Since the subject matter allegedly lacking written descriptive support is no longer present in any active claim, the reason for the rejection is rendered moot.

Accordingly, applicants submit that the rejection under §112, ¶1, for allegedly failing to comply with the requirement for a written description, is overcome and withdrawal of the rejection appears to be in order.

Claim 22 was rejected under 35 USC 112, first paragraph, as allegedly lacking enablement. Reconsideration is requested.

According to the statement of rejection (Office Action, page 8, item no. 5),

the specification, while being enabling for an assay for screening for *a modulator of the minor vault protein ADPRTL1*, whereby the modulator is modulating substances

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According to the statement of rejection (Office Action, page 8, item no. 5),

the specification, while being enabling for an assay for screening for *a modulator of the minor vault protein ADPRTL1*, whereby the modulator is modulating substances

consisting of a translation product of a gene coding for a vault protein, the minor vault protein ADPRTL1 as shown in SEQ ID NO: 2, and the method comprising: a) contacting a cell with a test compound; b) measuring the activity and/or level of the substances recited; c) measuring the activity and/or level of the substances in a control cell not contacted with the test compound; and d) comparing the levels and/or activities of the substances in the cells of steps b) and c), wherein an alteration in the activity and/or level of substances in the contacted cells indicates that the test compound is a modulator of Alzheimer's disease.

Present claim 24 is limited to the aforesaid subject matter—an assay for screening for ADPRTL1 comprising contacting a cell with a test compound, measuring activity and/or level of substances—and the same for a control cell not contacted with the test compound, and comparing the levels and/or activities of the substances in the cell and control cell, wherein an alteration thereof in the contacted cell indicates the test compound is a modulator of Alzheimer's disease—found enabled by the examiner, but using the transitional phrase "comprising."

Moreover, the passage "or related diseases or disorders"—recited in claim 22—is not found in present, replacement claim 24.

For the foregoing reasons, applicants submit that the rejection under § 112, ¶ 1, for allegedly lacking enablement is overcome. Accordingly, withdrawal of the rejection appears to be in order.

Claim 22 was rejected under 35 USC 102(b) for being allegedly anticipated by Rome (WO 99/62547). Reconsideration is requested.

Rome discloses human minor vault protein p193—minor vault protein ADPRTL1, by a different name. The reference also discloses a method of diagnosing multidrug-resistant (MDR) cancer.

The statement of rejection relies, *i.a.*, on the disclosure by Rome of MDR cancer. That is, MDR cancer allegedly meets the alternatively recited subject matter "or related diseases or disorders," in claim 22.

Present replacement claim 24 does not recite the "or related diseases or disorders" subject matter. Claim 24 recites only "Alzheimer's disease," i.e., the remaining alternative subject matter—to the "or related diseases or disorders" alternative—from claim 22.

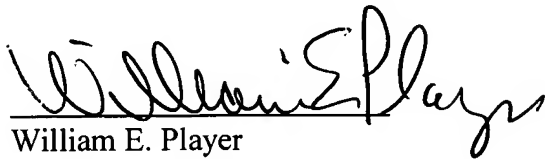
Rome neither teaches nor suggests the limitation to "Alzheimer's disease," as recited in present claim 24. The "absence" from Rome of this single claim limitation "negates anticipation" of the claim by Rome. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*).

Since Rome does not anticipate present claim 24, the rejection under §102(b) based on Rome is overcome. Withdrawal of the rejection appears to be in order.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By 
William E. Player
Reg. No. 31,409

400 Seventh Street, NW
The Jenifer Building
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
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